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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,688	09/30/2003	David J. Park	66329/31349	6172
23380	7590	09/15/2008		
TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414			EXAMINER ROBINSON, MYLES D	
			ART UNIT	PAPER NUMBER
			2625	
			NOTIFICATION DATE	DELIVERY MODE
			09/15/2008 ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/675,688

Applicant(s)

PARK ET AL.

Examiner

Myles D. Robinson

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 - 16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 5/22/2008, and has been entered and made of record. Currently, **claims 1 – 16** are pending.

Response to Arguments

2. Applicant's arguments (*see Interview Summary 2/26/2008 and Remarks 5/22/2008 [page 8, line 26 – page 9, line 5]*) with respect to the rejections of **claims 1 – 16** under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of **McGraw** (U.S. Patent No. 6,542,261).

Drawings

3. The drawings were received on 5/22/2008. These drawings are acceptable.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1 – 16** are rejected under 35 U.S.C. 102(b) as being anticipated by **McGraw** (U.S. Patent No. 6,542,261).

Referring to **claim 1**, McGraw discloses a system for processing of electronic documents comprising:

image generating means (see *Fig. 1, multifunction printer/FAX machine 12*) for generating an electronic representation of a paper document (see *Fig. 1, document 28 [column 2, lines 53 – 55 and column 3, lines 33 – 45 and 49 – 52]*),

the image generating means including means for receiving an associated tangible template sheet (see *Fig. 3 wherein the control form [e.g. cover sheet] is analogous to a tangible template sheet inclusive of a plurality of indicia [i.e. checkboxes] corresponding to instructions [column 5, lines 52 – 56 and column 6, lines 22 – 24]*) inclusive of a plurality of indicia corresponding to an instruction for a desired document processing operation (see *Fig. 3 wherein the checkboxes within the sections Resolution [e.g. standard, fine], Copy/Scan Type [e.g. black/white, color, resolution modes such as draft, normal and best] and Copy Setting [e.g. copy size, quantity, collation] are analogous to desired document processing operations) and an instruction specifying a selected electronic document format (see *Fig. 3 wherein the checkboxes within the section Scan Setting [e.g. BMP file, JPG file, TIFF file] is analogous to selected electronic document formats*),*

optical recognition means for recognition of the instructions (column 5, lines 54 – 56, column 6, lines 18 – 20 and 22 – 24),

means for generating an instruction signal in accordance with a recognized instructions (column 5, lines 52 – 60, column 6, lines 18 – 20, 22 – 24, 39 – 46 and 57 – 62 wherein the system produces a secure FAX based upon the user's selections on the control form of Fig. 3),

means for controlling operation of an associated document processing device on the electronic representation of the paper document in accordance with the instruction signal so as to generate an electronic document in the specified electronic document format (see Fig. 6 wherein steps S20, S28 output the secured FAX document in accordance to the boxes checked [column 5, lines 52 – 60, column 6, lines 39 – 46 and 57 – 62]),

means for generating an output document in accordance with the controlled operation (see Fig. 6, steps S20, S28 [column 3, lines 1 – 6, column 6, lines 39 – 46 and 57 – 62]), and

means for communicating the output document in the specified electronic document format (see Fig. 1 wherein the scanned document 28 is transmitted via communication system 16 [column 3, lines 36 – 40]) to a destination in accordance with the instruction signal (see Fig. 3 wherein the section Fax Settings To: is analogous to a specified destination [column 5, lines 61 – 64]).

Referring to **claims 2 and 3**, McGraw discloses the system further comprising means for identifying a location of relevant markings on the template sheet,

wherein the means for identifying the location of relevant markings comprised as at least one of check boxes and fill-in boxes (*see Fig. 3 wherein the checkboxes are analogous to locations of relevant markings*).

Referring to **claim 4**, McGraw discloses the system further comprising means adapted for optically identifying handwritten characters on the template sheet (*see Fig. 3 wherein the Note section comprises handwritten characters to be scanned [column 5, line 61]*).

Referring to **claim 6**, McGraw discloses the system further wherein the output document is communicated via at least one of electronic mail transmission, facsimile transmission, FTP transmission, HTML transmission, and optical image rendering on an associated display (*see Fig. 1 wherein communication system 16 and connection 18 work in conjunction as either a telephone system or internet communication system [column 3, lines 36 – 40]*).

Referring to **claim 7**, McGraw discloses the system further wherein the output document is communicated to at least one of an electronic mail server, a document management system, an image generating device, and an Internet server (*see Fig. 1 wherein communication system 16 and connection 18 work in conjunction as either a telephone system or internet communication system [column 3, lines 36 – 40] wherein such systems inherently include servers and see Fig. 1 wherein either computer 32 or multifunctional printer/FAX machine 30 produces the secure FAX [column 4, lines 32 – 36]*).

Referring to **claim 8**, McGraw discloses the system further comprising verification means for verifying the desired document processing operation (*see Fig. 6, step S26 [column 5, lines 37 – 51 and column 6, lines 53 – 56]*).

Referring to **claims 9 – 16**, the rationale provided in the rejections of claims 1 – 8, respectively, are incorporated herein. In addition, the systems of claims 1 – 8 perform the methods of claims 9 – 16, respectively.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaltenecker et al. (U.S. Patent No. 6,816,277) discloses file conversion systems configured to receive information corresponding to a first format of image data and converting the first format of image data into a second format of image data (*see Abstract and Figs. 1 – 6*).

Braun et al. (U.S. Patent No. 7,417,773) discloses a method for creating and sending a facsimile using a digital pen and facsimile cover sheet (*see Abstract and Figs. 4 – 5*).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Myles D. Robinson/
Examiner, Art Unit 2625
9/8/08